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10/072,485	02/07/2002	Ron P. Handshoe	HANR 0101 PUS	3338
7590 09/07/2005			EXAMINER	
FROST BROWN TODD 201 FIFTH STREET 2200 PNC CENTER CINCINNATI, OH 45202			AMERSON, LORI BAKER	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

(17)

## Office Action Summary

Application No.

10/072,485

Applicant(s)

HANDSHOE, RON P.

Examiner

L. Amerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 19-20 is/are rejected.
- 7) ☒ Claim(s) 16 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2/7/02 .                      6) ☐ Other: \_\_\_\_\_

### **Response to Arguments**

1. Applicant's arguments with respect to claims 1-7 and 9-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- a. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Bean.

Bean discloses a device comprising an upper surface (12) and a convex lower surface (22; fig. 4), where the lower surface having a plurality of different radii (fig. 3) allowing the extremity to pivot about the lower surface in any direction, such that exercises utilizing the different radii can be performed without reorienting the extremity on the upper surface (col. 3, lines 36-41). Bean teaches a flat area on the lower surface.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- b. Claims 15, 17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over et al Weck in view of Stodgell. Weck et al discloses steps

comprising providing an apparatus having a first and second surface (col. 9, lines 27-31); the *first surface* is generally elliptical or capable of being generally hemispherical (col. 4, lines 21-22); disposing the apparatus between the extremity and a support surface, wherein the extremity contacts the first surface and the second surface contacts the support surface and pivotally moving the extremity while it remains on the first surface wherein the radius of curvature of the movement varies depending upon the direction the extremity is pivoted (fig. 7D; col. 10, lines 41-45 ). Since applicant has deemed the shape as a preferred embodiment, note that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Weck does not teach a second surface being hemi-ellipsoidal. Thus Stodgell teaches a second surface being hemi-ellipsoidal in Figure 2 (20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Weck in view of the teaching of Stodgell such that a second surface is capable of being a different shape to provide the user with increased flexibility in movement on a platform. As to claim 17, comprising the step of placing at least one foot on the first surface and the placing the second surface in contact with a floor (fig. 7D). As to claim 19, comprising the step of placing at least one hand on the first surface and the placing the second surface in contact with a floor (fig. 7D). As to claim 20, see the paragraph for claim 15. Additionally, shifting at least a portion of the user's weight to the foot on the first

surface, such that the user must at least partially balance on the apparatus (col. 2, lines 34-39).

c. Claims 1-3, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bean in view of Stodgell. Bean discloses a first surface (12) for receiving at least one extremity (col. 2, line 47) and a second surface (20) for contacting a support surface, wherein the second surface allows for pivotal movement of the extremity in any direction, and the radius of curvature of the movement varies depending upon the direction the extremity is pivoted (figs. 4-5). Bean discloses all of the limitations of the claimed invention except for the second surface being generally hemi-ellipsoidal. Thus, Stodgell shows a second surface generally in a hemi-ellipsoidal shape (20). It would have been obvious to one having ordinary skill in the art to modify the second surface of Bean in view of the teaching of Stodgell that such a hemi-ellipsoidal shaped second surface provides additional pivotal movement in any direction to the user while atop the upper surface and exercising. Furthermore, a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). As to claim 2, as broadly as claimed, the first surface flat and *generally* elliptical having a major and minor diameter (fig. 1; col. 2, lines 50-51). Bean discloses all of the limitations of the claimed invention except for the second surface being generally elliptical. Thus, Weck shows a first surface capable of having an elliptical shape (col. 4, lines 20-22). It would have been obvious to one having ordinary skill in the art to modify the first surface of

Bean in view of the teaching of Weck that such an elliptically shaped first surface provides a larger area of movement for foot placement of the user while exercising. Furthermore, a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). As to claim 3, the language "wherein a thickness is defined as the distance from the first surface to the second surface measured along a line approximately normal to the first surface and passing through the intersection of the major and minor diameters" has not been given patentable weight because the recitation is purely functional in nature and does not recite and structure. Regarding the length of the major diameter being 13.5 inches and the minor diameter about 6.0 inches and the thickness about 3.0 inches, since applicant has not deemed the dimensions critical in the disclosure (page 4, lines 7-17), merely a preferred embodiment, then, absent a teaching as to criticality that the length of the diameters and thickness be 13.5, 6.0 and 3.0 respectively, this particular agreement is deemed to be known by those skilled in the art since the instant application and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7,9 (CCPA 1975). As to claim 5, the second surface of Bean further comprises a flat area (fig. 2, see examiner annotation allowing the apparatus to remain stationary with the first surface oriented upward when the apparatus is not in use. As to claim 6, the second surface further comprises a generally flat, circumferential band disposed adjacent to the first surface (20).

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As to claim 7, as best understood by the examiner, a plate (12) is attached to the upper surface.

d. Claim 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bean and Stodgell as applied to claim 1 above and further in view of Silverman and Weck et al. Bean discloses all of the limitations of the claimed invention except for the plastic device being one piece and made from polyethylene.

Silverman teaches an apparatus comprises a polyethylene material (col. 2, line 47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the material selection of Bean in view of the teaching of Silverman that such polyethylene, a plastic, would be capable of providing the same level of durable quality to the user while the device is in use. Furthermore, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 967, 125 USPQ 416 (CCPA 1960). Regarding the one-piece device, Weck teaches a one-piece device (fig. 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the device as a unitary piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

e. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bean as applied to claim 8 above and further in view of Silverman. As to claim 9, see the paragraph for claims 1-2 above. As to claim 10, the apparatus

comprises a foam material (col. 3, lines 5-7). Bean discloses all of the claimed invention except for the material density greater than about 2.5 pounds per cubic foot. Since applicant has disclosed the density as a preferred embodiment and absent a teaching as to criticality that the density be greater than about 2.5 pounds per cubic foot, this particular agreement is deemed to be known by those skilled in the art since the instant application and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7,9 (CCPA 1975). As to claim 11, as best understood by the examiner, a plate (12) is attached to the upper surface.

f. Claims 12-13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bean and Skaja in view of Weck et al and Silverman. As to claim 12, see the paragraphs for claims 3, 4, 8 and 10 above. Furthermore, the second surface substantially hemi-ellipsoidal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bean in view of the teaching of Skaja such that the shape of a second surface is capable of changing to accommodate a variety of movements of a user. As to claim 13, see paragraph 2 above. As to claim 14, see the paragraph for claim 3 above.

***Allowable Subject Matter***

3. Claims 16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of



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reasons for the indication of allowable subject matter: the prior art of record fails to teach singularly or an obvious combination of a method comprising the steps of placing at least one foot or hand on the first surface and placing the second surface in contact with a wall.

***Conclusion***

4. Note the references cited on Form 892 having hemi-ellipsoidal second surfaces. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Amerson whose telephone number is (571)272-4971. The examiner can normally be reached on Mon.-Fri from 8-5 p.m. Interviews Tue. And Thur..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
L. Amerson